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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

PORTNER, VIRGINIA ALLEN

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1645

DATE MAILED: 06/19/2002

28

Please find below and/or attached an Office communication concerning this application or proceeding.



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Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

### ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

a) ☒ is extended to run 4 mo or continues to run \_\_\_\_\_ from the date of the final rejection

b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 5/14/02 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- a. ☒ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☒ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☒ They raise the issue of new matter. (See Note).
- d. ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attached.

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: none  
Claims objected to: none  
Claims rejected: 1-6, 8-10

However;

☒ Applicant's response has overcome the following rejection(s): none, not entered

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because none - not entered; see attached.

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

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## **DETAILED ACTION**

Claims 1-6 and 8-10 are pending.

### ***Response to Amendment***

1. The Amendment submitted After-Final has not been entered because the amendment of the specification at page 3 would raise new issues with respect to New Matter.
2. While Applicant asserts that originally presented claim 3 provides original descriptive support for the claimed kits which detect a protein macromolecule, the examiner upon reconsideration of the originally presented claims, found claim 3 to depend from claim 1 which did not define the macromolecule to be a protein. The macromolecule of original claim 1 was not defined to be a protein. While kits that comprise nucleic acids were originally claimed and could be readily used to detect nucleic acid binding nucleotide sequences, a subgenus of nucleic acids that detect any protein macromolecule was not described.

Amendment of the specification at page 3, with the proposed insertion of a paragraph between paragraphs 3 and 4, to recite the claim limitations of original claim 3 relative to the determination of any protein macromolecule would introduce New Matter into the specification.

3. The New Matter rejection of claims 1, 3 and 4 was made over the amended claims directed to a subgenus of species of kits for the detection of any protein macromolecule utilizing

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the combination of three nucleic acids or co-factors. This subgenus of species was not specifically taught in the instant specification and is therefore considered to be New Matter.

Claims directed to a genus kits that comprise 3 nucleic acid molecules for the determination of a macromolecule would not be considered to contain New Matter, because the macromolecule would naturally be a polynucleotide or DNA containing macromolecule.

The proposed Amendment of claim 1 seeks to further define kits that comprise three nucleic acids or cofactors (claim 3-4) that bind to protein macro molecules, which previously have been rejected as being directed to a subgenus of species of invention for which original descriptive support could not be found.

Original claim 1 from which claims 3-4 depend was not limited to proteins, but defined the genus to be macro molecules of any type. Claims directed to kits that comprise three nucleic acid molecules that specifically detect a nucleic acid macromolecule would not contain new matter or claims which recite the originally presented claim limitations of claim 1 also would not contain new matter.

4. All arguments with respect to the applied prior art, are directed to the proposed amendments of the claims and specification which have not been entered.

5. Non-entry of the proposed Amendment Final dated May 16, 2002 is for the reasons set forth above.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (703)308-7543. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM except for the first Friday of each two week period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this group is (703) 308-4242.

The Group and/or Art Unit location of your application in the PTO will be Group Art Unit 1645. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to this Art Unit.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Vgp

June 17, 2002

  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600